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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,841	01/05/2006	Stein Kuiper	NL 030873	5326
24737 7590 08/28/2008 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
SUGARMAN, SCOTT J				
ART UNIT		PAPER NUMBER		
2873				
MAIL DATE		DELIVERY MODE		
08/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,841

Applicant(s)

KUIPER ET AL.

Examiner

Scott J. Sugarman

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 7-23 of U.S. Patent No. 7,311,398 in view of Okada et al (4,756,605) or Stoner (US 5,182,585), of record. Although the conflicting claims are not identical, they are not patentably distinct from each other because the variable focus lens structure of claims 1 and 7-23 of US Patent 7,311,398 is not specifically included in a spectacle lens system. Okada et al teaches it is well known to use a (different) liquid crystal lens system in a spectacle arrangement for

vision correction. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the variable focus lens structure of claims 1 and 7-23 of US Patent 7,311,398 in a spectacle lens, since as taught by Okada et al these types of fluid lenses are used in a spectacle lens and doing so would have provided predictable results. Note, for example, the two fluids can have substantially identical specific gravity (('398), claim 15); an oil and an electrolyte can be used as first as second fluids (('398), claim 17); the electrolyte can be a salt/water mixture (('398), claim 20) and so forth. Okada et al teaches that there can be a variable resistor (60) for adjustment means. Stoner is cited to show it is well known to use a sensing and range finding system (Fig. 5) in a fluid type spectacle lens system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sensing and range finding system of the spectacle system Stoner in the variable lens of claims 1 and 7-23 of US Patent 7,311,398, since this would have yielded predictable results.

Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 7-10 of U.S. Patent No. 7,311,398. Although the conflicting claims are not identical, they are not patentably distinct from each other because the variable focus lens of claims 1 and 7-10 of US Patent No. 7,311,398 also includes limitations that are not required by claim 14 (such as biocompatible material, for example).

Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 7,245,439 in view of Okada et al or Stoner (US 5,182,585), of record. Although the conflicting claims are not identical, they are not patentably distinct from each other because the variable focus lens structure of claims 1-14 of US Patent 7,245,439 is not specifically included in a spectacle lens system. Okada et al teaches it is well known to use a (different) liquid crystal lens system in a spectacle arrangement for vision correction. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the variable focus lens structure of claims 1-14 of US Patent 7,245,439 in a spectacle lens, since as taught by Okada et al these types of fluid lenses are used in a spectacle lens and doing so would have provided predictable results. Okada et al teaches that there can be a variable resistor (60) for adjustment means. Stoner is cited to show it is well known to use a sensing and range finding system (Fig. 5) in a fluid type spectacle lens system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sensing and range finding system of the spectacle system Stoner in the variable lens of claims 1-14 of US Patent 7,245,439, since this would have yielded predictable results.

Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12 of U.S. Patent No. 7,245,439. Although the conflicting claims are not identical, they are not patentably distinct from each other because the variable focus lens of claims 1 and 12 of US Patent No.

7,245,439 also includes limitations that are not required by claim 14 (such as a plurality of annuli, for example).

Applicants' arguments filed June 10, 2008 have been fully considered but they are not persuasive. Applicants argue that a terminal disclaimer will be submitted to overcome this rejection upon indication by the Examiner that the claims of the present application may be allowable except for possible double patenting. Since the double patenting rejections are the only rejections in this application, a terminal disclaimer should overcome the double patenting rejection. **Please note that another US Patent, 7,245,439, has also been used to make another rejection, so that two terminal disclaimers, pertaining to each of the two patents, will now be required.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott J. Sugarman whose telephone number is (571)272-2340.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571)272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott J. Sugarman/
Primary Examiner, Art Unit 2873

sjs
August 26, 2008